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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/613,646	07/02/2003	Burns Phillips	50243-0001	4622

7590

06/29/2005

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EXAMINER

REIMERS, ANNETTE R

ART UNIT

PAPER NUMBER

3732

DATE MAILED: 06/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/613,646	PHILLIPS ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Annette R. Reimers	3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 June 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 October 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)                        |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____   |

## DETAILED ACTION

### *Election/Restrictions*

This application contains claims directed to the following patentably distinct species of the claimed invention:

Species (Retractor frame)

- I. Figures 1-2
- II. Figures 3a-3b
- III. Figures 4a-4b
- IV. Figures 5

Subspecies (Retractor clamp)

- I. Figures 7-10
- II. Figure 11
- III. Figure 12

Sub-subspecies (Retractor blade)

- I. Figures 14-15
- II. Figures 16-17

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claims appear to be generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

During a telephone conversation with Stephen Stark on June 16, 2005 a provisional election was made with traverse to prosecute the invention of Species II, Figures 3a-3b, Subspecies I, Figures 7-10 and Sub-subspecies I, Figures 14-15, with all claims reading on the elected species, subspecies and sub-subspecies. Examiner agrees with applicant regarding all claims reading on the elected species, subspecies and sub-subspecies. Affirmation of this election must be made by applicant in replying to this Office action.

### ***Drawings***

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: reference numbers 30 on page 5, line 3 of the specification, 122 on page 8,

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line 19 of the specification and 146 on page 9, line 14 of the specification. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

The specification is objected to as failing to comply with 37 CFR 1.84(p)(5), which states: "Reference characters not mentioned in the description shall not appear in the drawings. Reference characters mentioned in the description must appear in the drawings." Reference number 206 is not mentioned in the detailed description. Correction is required. In addition, there appears to be a typographical error in the Brief Description of the Drawings, i.e. the second Figure 4a should be Figure 4b.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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Claims 1-3, 5-9, and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Gauthier (U.S. Patent Number 3,384,077).

Gauthier discloses a surgical retractor comprising a laterally extending rack, 466, with a proximal and distal end, a first arm, 460, connected to the rack at a first location and extending longitudinally from the first location to an end, a moveable second arm, 462, having a housing, 472, slidably engaging a portion of the rack and extending longitudinally from the housing to an end, the housing having an adjustment mechanism for allowing the positioning of the housing relative to the rack at a desired location (see figure 32) and a retractor clamp, 120, having a slot therein and slidably engaged on the second arm, and the clamp having a leg, 302, with a mount, 324, for receiving a connector head of a retractor blade (see figure 20). The clamp further comprises a member, 334, containing the slot therein and a latch connected to the member (see figure 20). The clamp also comprises a member, 306, housing the slot intermediate upper and lower surfaces and a latch is coupled to the lower surface biased into a plane of the slot to selectively retain the clamp relative to the second arm (see figure 20).

The leg is positionable relative to the member (see figure 3). A threaded adjustment mechanism, 132, is coupled to the leg and moves the leg relative to the member (see figure 3). A release member, 134, disengages the shaft from the member and the leg and the leg has a projection, 130, in which the threaded shaft passes through (see figure 3). Gauthier teaches a plurality of teeth on the arms (see column 4, lines 25-32). Gauthier further discloses a hand held gripper having a handle connected to a shaft (see figure 7).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gauthier (U.S. Patent Number 3,384,077).

Gauthier discloses the claimed invention except for the slot being substantially parallel to the mount. It would have been an obvious matter of design choice to one skilled in the art at the time the invention was made to construct the surgical retractor of Gauthier having the slot being substantially parallel to the mount, since applicant has not disclosed that such solves any stated problem or is for any particular purpose other than aesthetics. Furthermore, it is noted that matters relating to ornamentation which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art. In re Seid, 161 F.2d 229, 73 USPQ 431 (CCPA 1947).

Claims 10 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gauthier (U.S. Patent Number 3,384,077) in view of Kohlmann (U.S. Patent Number 3,749,088). Gauthier discloses the claimed invention except a pivot connecting the member and the leg, the threaded shaft having a nut which moves along an axis of the shaft, and a release coupled to the latch. Kohlmann discloses a surgical retractor with a slidable clamp having a member, 66, and a leg, 25, a pivot, 104, a nut on the

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threaded shaft, 27, and a latch, 83 (see figure 18). Kohlmann teaches that use of the retractor device increases the ability to adjust the retractor arm means and retractor blade means to any one of several positions relative to an incision during the performance of surgery on a patient (see column 2, lines 43-46). It would have been obvious to one skilled in the art at the time the invention was made to construct the device of Gauthier with a pivot connecting the member and the leg, the threaded shaft having a nut which moves along an axis of the shaft, and a release coupled to the latch in view of Kohlmann, in order increase the ability to adjust the retractor arm means and retractor blade means to any one of several positions relative to an incision during the performance of surgery on a patient.

Claims 13-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gauthier (U.S. Patent Number 3,384,077) in view of LeVahn (U.S. Patent Number 5,020,195). Gauthier discloses the claimed invention except for the hand held gripper having a shoe with a slot, connected to the shaft, the shaft being rotatable relative to the shoe, comprising a post that extends into the slot, and the shaft being angularly connected relative to the shoe. LeVahn discloses a surgical retractor with a hand held gripper having a handle, 76, connected by a shaft, 66, to a shoe containing a slot, 26, and a post, 56. LeVahn teaches that use of the retractor device permits movement of the retractor along the retractor support in a quick and efficient manner before and during surgery (see column 2, lines 44-47). It would have been obvious to one skilled in the art at the time the invention was made to construct the device of Gauthier with the hand held gripper having a shoe with a slot, connected to the shaft, the shaft being



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rotatable relative to the shoe, comprising a post that extends into the slot, and the shaft being angularly connected relative to the shoe in view of LeVahn, in order to permit movement of the retractor along the retractor support in a quick and efficient manner before and during surgery.

### ***Conclusion***

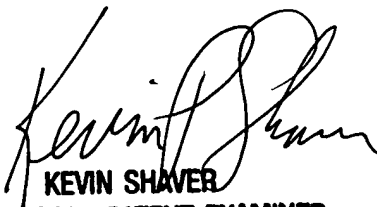
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO 892 for art cited of interest.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Annette R. Reimers whose telephone number is (571) 272-7135. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached on (571) 272-4720. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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